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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,941	11/04/2003	Erich Ambruster	L.P.1825	9770

7590 11/21/2005

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EXAMINER

COVINGTON, RAYMOND K

ART UNIT PAPER NUMBER

1625

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,941	Applicant(s) ARMBRUSTER ET AL.	
	Examiner Raymond Covington	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/13/01, 2/11/02, 11/4/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-49 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/13/01</u> . | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Bessard et al US 6,600,046.

Bessard et al teach the claimed 6-methylpyridine-3-yl)-2-[4-(methylsulfonyl)phenyl]ethanone as claimed. See, for example, column 1 lines 12-26.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pye et al WO 98/47871

Determination of the scope and content of the prior art (MPEP 2141.01)

Pye et al teach alkyl-methylsulfonyl ethanone substituted pyridine compounds of the same type recited in the claims. see, for example, page 4 lines 5-25.

Ascertainment of the difference between the prior art and the claims (MPEP

2141.02)

It is noted that Ar reads on phenyl or pyridinyl, substituted with C₁₋₄ alkyl and R¹ reads on CH₃.

Finding of prima facie obviousness--rational and motivation (MPEP 2142-

2413)

It would have been obvious to one of ordinary skill in the art to modify Pye et al due to the close structural relationship as the results would not have been unexpected.

Claims 21-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessard et al US 6,600,046 and/or Pye et al WO 98/47871 in view of Badia et al Bull. Soc. Chim. Belg. Vol. 98 no. 1 (1989) .

Determination of the scope and content of the prior art (MPEP 2141.01)

Bessard et al and Pye et al are applied as in the above rejections. Badia et al teach an analogous process using acetonitrile reactants of the type recited in the claims. see the results and discussion.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

Bessard et al and Pye et al differ in that they do not teach the process steps recited in the claims. However, Badia et al teach an analogous process using acetonitrile reactants of the type recited. While Badia et al teach sing only analogous phenyl substituted reactants it is noted that Pye et al teach phenyl and pyridine to be readily substituted in lieu of one another. See page 4 definition for Ar.

Finding of prima facie obviousness--rational and motivation (MPEP 2142-2413)

To modify the process of Badia et al to include phenyl in lieu of pyridine would have been obvious to one of ordinary skill in the art as the use of somewhat different but otherwise analogous starting materials in an otherwise known process would not have been unexpected.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amano et al US 6,642,387.

Determination of the scope and content of the prior art (MPEP 2141.01)

Amano et al teach pyridine sulfonic acid of the type recited in the claims. see, for example, column 2 lines 15-45.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

Amano et al differs in that the 6-position substituent is not methyl. It is e.g. methoxy.

Finding of prima facie obviousness--rational and motivation (MPEP 2142-2413)

The claimed compounds in light of the teachings as a whole would have been obvious to one of ordinary skill in the art due to the otherwise close structural relationship.

Claims 46-49 which process is neither taught nor suggested by the prior art would be allowed if they did not depend from a rejected base claim and are therefore objected to.

No claim is allowed.

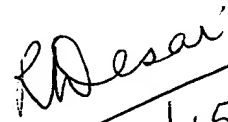
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (571) 272-0681. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RKC

Raymond Covington
Examiner
Art Unit 1625


11/15/05